REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 11-20 are presently pending in this application, Claims 1-10 having been canceled without prejudice or disclaimer and Claims 11-20 having been added by the present amendment.

In the outstanding Office Action, Claims 1-10 were objected to because of informalities; Claims 1-5 and 8-10 were rejected under 35 U.S.C. 102(b) as being anticipated by Ashby et al. (US. 5,911,723); and Claims 6 and 7 were objected to as being dependent upon a rejected base claim. However, Claims 6 and 7 were indicted as being allowable if rewritten in independent form. Applicant acknowledges with appreciation the indication of allowable subject matter.

In response to the objection to the disclosure, the specification has been amended to correct the informalities. No new matter has been introduced. Accordingly, no further objection on that basis is anticipated.

In response to the objection to Claims 1-10, Claims 1-10 have been canceled. Therefore, the objection is now moot.

New Claims 11-20 are fully supported by the specification, drawings and claims as originally filled.[2] Hence, no new matter is believed to be added thereby.

Briefly recapitulating, Claim 11 is directed to an apparatus in a knee replacement operation for measuring a joint gap and ligament balance between an osteotomized surface at a femur distal end and an osteotomized surface at a tibia proximal end. For example, referring to the non-limiting embodiment of Figs. 1, 6 and 9, the apparatus includes a base 10, a first engaging member 14 on the base for an engagement with the osteotomized surface at the tibia proximal end, a moving body 18, and a second engaging member 22 on the moving body 18 for

an engagement with the osteotomized surface at the femur distal end. The second engaging member 22 is rotatable on the moving body 18 about an axis substantially parallel with respect to the osteotomized surface at the femur distal end. The base 10 and the moving body 18 are connected with each other so that the first and second engaging members 14, 22 are selectively moved between a direction where the first and second engaging members are moved toward each other and a direction where the first and second engaging members are moved away from each other. A driving member is configured to move the moving body 18 with respect to the base 10 so that the first and second engaging members are moved in the direction away from each other. A stopper is provided on the moving body 18 and configured to engage with the driving member to restrain the movement of the driving member in the direction where the first and second engaging members are moved toward each other. A first indicator is configured to indicate the value corresponding the spacing between the first and second engaging members. A second indicator is configured to indicate the value corresponding the angle between the first and second engaging members.

The first and second engaging members have an offset structure with respect to the base and moving body, respectively, so that measuring operation is performed without patella eversion.

Due to this offset structure, in the tensor according to the present invention recited in Claim 11, a gap measurement can be done without patella eversion. Namely, the base 10 and the moving body 18 do not hinder that the patellar tendon L is located at its original position (anterior position) as shown by the line P in Fig. 9. In other words, a gap measurement by the tensor according to the present invention recited in Claim 11 is done at a physiological intrinsic

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[2] The present application, for example, Figs. 1, 6 and 9.

position of patella. Namely, a gap measurement by a tensor is done at two positions, that are an extended condition where the flat osteotomized surface of the tibial bone is parallel with respect to the flat osteotomized surface FA at the end of the femoral bone as shown in Fig. 7 and a flexed condition where the flat osteotomized surface FB on the rear side of the femoral bone is parallel with respect to the flat osteotomized surface of the tibial bone as shown in Fig. 8. According to the present invention recited in Claim 11, these measurements at these two positions are done without patella eversion, i.e., an original physiological position of patella. Thus, the tensor according to the present invention recited in Claim 11 can realize a physiologically idealized measurement.[3]

The Office Action asserts that Ashby et al. disclose the present invention. However, Applicant notes that a claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Californial*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As will be demonstrated below, Ashby et al. clearly do not meet each and every limitation of Claim 11.

The Office Action asserts Ashby et al. disclose an apparatus having a base (1), a first engaging member (3), a moving body (4), second engaging member (5), moving member (33), driving member (17), a locking member (18), a first indicator (33), and a second indicator (9 and 11).[4]

[3] See the present specification, page 16, line 17 to page 17, line 26.
[4] See the outstanding Office Action, page 3, lines 3-9.

However, Ashby et al. fail to disclose the first and second engaging members 3, 5 have an offset structure with respect to the base 1 and moving body 4, respectively, so that measuring operation is performed without patella eversion (see Fig. 3). Instead, Ashby et al. disclose that the first and second engaging members 3, 5 do not have an offset structure with respect to the base 1 and moving body 4, respectively. Therefore, in the Ashby et al. apparatus, measuring operation requires patella eversion because the apparatus interferes with a patella (see Fig. 3).

Accordingly, Ashby et al. are not believed in any way to anticipate the specific features recited in Claim 11. Therefore, Claim 11 is believed to be allowable.

Likewise, independent Claim 15 includes subject matter substantially similar to what is recited in Claim 11 to the extent discussed above. Thus, Claim 15 is also believed to be allowable.

Dependent Claims 12-14 depend directly from Claim 11, and dependent Claims 16-20 depend directly or indirectly from Claim 15. Accordingly, substantially the same arguments as set forth above with regard to Claim 11 also apply to dependent Claims 12-14 and 16-20. Hence, each of the dependent claims is also believed to be allowable.

Consequently, in view of the present amendment, it is respectfully submitted that this application is in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully Submitted,

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Date

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